

**REMARKS****Amendments**

Claims 1-5, 9-19, and 25 have been amended. The amendments are supported by the disclosure as a whole, and, in particular, by paragraphs 7, 8, 9, 19, 29, 30, 32, 34, and by the examples of the invention.

**Rejection under 35 USC § 112**

Claim 25 was rejected as allegedly indefinite. Applicants respectfully submit that claim 25 as amended and all the claims meet the requirements of section 112.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested

**Rejection under 35 U.S.C. § 102 over the Rink Reference**

Claims 1-22 and 25 were rejected as anticipated by the Rink et al. reference, U.S. Patent 5,759,631. Applicants respectfully traverse the rejection and request reconsideration.

To anticipate, the prior art must disclose the claimed range with sufficient specificity. "An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention." *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). If the claims are directed to only part of a broader range disclosed in the prior art, and there is evidence of unexpected results within the narrower, claimed range not disclosed or appreciated by the prior art, then the prior art does not disclose the claimed subject matter with the required specificity. *Ultradent Products Inc. v. Life-*

*Like Cosmetics, Inc.*, 44 U.S.P.Q.2d 1336 (Fed. Cir. 1997) (to be anticipating, the prior patent must "describe to one of skill in the art the tested combinations, or other combinations meeting the limitations of the claims, from among the many possible candidates." ; *Minnesota Mining and Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992) (no anticipation when the prior reference was not "exact enough to identify" what the parameters were that would produce the beneficial properties); MPEP 2131.03 (evidence of unexpected results within the claimed narrower range support conclusion narrower range not disclosed with "sufficient specificity" to anticipate).

Such is the present situation. The Rink patent discloses a polyacrylate resin that may have as little as 5 weight percent of cycloaliphatic (meth)acrylate. The Rink patent provides no example of a resin including at least 45% by weight of a cycloaliphatic monomer. All of the examples the Rink patent discloses have less than 45% by weight of a cycloaliphatic monomer, and none of the examples has a number average molecular weight of at least about 5000.

Moreover, there is evidence of unexpected results. As described above in the section "Summary of Evidence Submitted by Applicants During Prosecution," Applicants' claimed coating provides significantly shorter dust dry and tack-free times than those reported by the prior art reference. Applicants considered polyacrylate resin E3 to be the closest polyacrylate example in the Rink patent. The E3 example had an extremely low number average molecular weight, 2711, which, even increased to 4100, had significantly longer dust-free and tack-free times as compared to Appellants' invention. Example 5 according to the invention had a dust free time of 67.5 minutes,

while Comparative Example C based on the Rink polyacrylate had a dust free time of 82.5 minutes. Example 5 of the invention had a tack free time of 270 minutes, while Comparative Example C had a tack free time of 360 minutes.

The other Rink patent examples of refinish clearcoats include polyacrylate resins with 14% by weight to 23% by weight t-butylcyclohexyl acrylate and number average molecular weights of from 2400 to 2700.

In addition, the Rink patent does not teach or disclose refinish compositions including at least one film-forming polymer in addition to its polyacrylate resin. Moreover, the Rink patent does not teach or disclose that its polyacrylate resin should be from about 5% up to 60% by weight of the combined weight of its polyacrylate resin and of a film-forming polymer other than its polyacrylate.

Further, with regard to claim 10, the Rink patent does not teach an acrylic polymer is polymerized from monomers comprising from about 1% to about 25% by weight of a combination of styrene, n-butyl methacrylate, and n-butyl acrylate, based on the total weight of monomers polymerized.

Further, with regard to claim 25, claim 25 depends on claim 24, which specifies that the hydroxyl-functional acrylic polymer that is polymerized using at least about 45% by weight of a cycloaliphatic monomer has a number average molecular weight of at least about 8000. The Rink patent does not disclose a refinish composition as in claim 1 in which the acrylic polymer has a number average molecular weight of at least about 8000. The Rink patent explicitly limits the number average molecular weight of its polyacrylate resin to from 1000 to 5000. Column 2, line 21; column 3, line 17; column 4, lines 5-6; Examples (Table 2 data in column 11).

The Rink patent does not teach one of ordinary skill in the art how to design a refinish clearcoat composition that will have the advantages of shorter dry times and shorter tack free times. Because the Rink patent does not disclose each and every limitation of the claims, Appellants respectfully submit that the present claims are patentable over the Rink patent. Withdrawal of the rejection and reconsideration of the claims are requested.

Rejection under 35 U.S.C. § 102(b) over the Rockrath Reference

Claims 1-15, 22, and 23 were rejected as anticipated by the Rockrath et al. patent, U.S. Patent 5,716,678. Applicants respectfully traverse the rejection and request reconsideration.

Claims 1-15, 22, and 23 are not anticipated by the Rockrath patent because the Rockrath patent, like the Rink patent, does not disclose with *sufficient specificity* a composition containing an acrylic polymer polymerized using the claimed amount of at least about 45% by weight of a cycloaliphatic monomer, based on the total weight of monomers polymerized. The Rockrath disclosure is even less specific than the Rink patent disclosure. While the Rink patent disclosed a broad range of 5-80 weight percent of a cycloaliphatic (meth)acrylate, the Rockrath need not contain a cycloaliphatic monomer at all, as it can instead contain any aliphatic monomer (i.e., linear also) ester of methacrylic acid which is different from its hydroxyl monomers that has at least 4 carbon atoms in the alcohol radical, or of a mixture of such monomers.

Just as for the Rink patent, Appellants' evidence of unexpected results for the refinish clearcoat composition of the invention containing an acrylic polymer having a

number average molecular weight of at least about 5000 and polymerized using at least about 45% by weight of a cycloaliphatic monomer demonstrates that the Rockrath patent does not disclose the claimed range (and monomer) with sufficient specificity to establish anticipation.

Secondly, the Rockrath patent does not disclose a *refinish* coating composition. The Rockrath coating compositions are formulated to cure at high bake, OEM cure conditions. As evidenced by the excerpt from the "Coatings" article from the Encyclopedia of Polymer Science and Engineering and the discussion in paragraphs 3 and 4 of the present application, automotive refinish coating compositions are recognized as a distinct coatings technology. One key attribute and requirement of a refinish coating is the ability to cure at room temperature or a very low temperature of room temperature or up to about 150°F (65°C.). This important attribute is lacking in the Rockrath compositions, which must be cured at high bake temperatures. The Rockrath patent nowhere describes or suggests a refinish coating composition, nor does the Examiner contend that it does. Because it does not describe a refinish coating composition, however, it cannot anticipate the present claims.

In addition, the Rockrath patent does not teach or disclose refinish compositions including at least one film-forming polymer in addition to its polyacrylate resin. Moreover, the Rockrath patent does not teach or disclose that its polyacrylate resin should be from about 5% up to 60% by weight of the combined weight of its polyacrylate resin and of a film-forming polymer other than its polyacrylate.

It is thus submitted that the Rockrath patent does not anticipate the present claims. Reconsideration of the claims is respectfully requested.

Rejection under 35 U.S.C. § 102(b) over WO 97/22646

Claims 1-3, 5-21, and 23-25 have been rejected as anticipated by WO'646.

Applicants respectfully traverse the rejection and request reconsideration of the claims.

With regard to claims 1-3, 5-12, and 23, the WO'646 publication does not teach or disclose a refinish composition. Additionally, the WO'646 publication does not teach or disclose such a composition containing a combination of an hydroxyl-functional acrylic polymer, wherein the acrylic polymer has a number average molecular weight of at least about 5000 and is polymerized using at least about 45% by weight of a cycloaliphatic monomer, based on the total weight of monomers polymerized and at least one film-forming polymer different from this acrylic polymer, wherein the acrylic polymer is from about 5% up to about 60% by weight of the combined weight of the acrylic polymer of and the film-forming polymer or polymers. Further, regarding claim 10, the WO'646 publication does not teach or disclose an acrylic polymer polymerized using at least about 45% by weight of a cycloaliphatic monomer and from about 1% to about 25% by weight of a combination of styrene, n-butyl methacrylate, and n-butyl acrylate. Finally, the WO'646 publication does not teach or disclose the viscosity limitations of claims 11-12.

With regard to claims 13-15, the WO'646 publication does not teach or disclose a refinish multi-component coating composition. Further, the WO'646 publication does not teach or disclose that one component comprises an hydroxyl-functional acrylic polymer that has a number average molecular weight of at least about 5000 and is polymerized using at least about 45% by weight of a cycloaliphatic monomer, and at

least one film-forming polymer different from the acrylic polymer wherein the acrylic polymer is from about 5% up to about 60% by weight of the combined weight of the acrylic polymer and the film-forming polymer or polymers. Nor does the WO'646 publication teach or disclose such a composition in which a second component curing agent is reactive with at least one film-forming polymer.

Regarding claims 16-21, 24, and 25, the WO'646 publication does not teach or disclose a method of refinishing a substrate. Nor, again, does the WO'646 publication teach or disclose a refinish clearcoat containing an hydroxyl-functional acrylic polymer that has a number average molecular weight of at least about 5000 and is polymerized using at least about 45% by weight of a cycloaliphatic monomer, and at least one film-forming polymer different from the acrylic polymer wherein the acrylic polymer is from about 5% up to about 60% by weight of the combined weight of the acrylic polymer and the film-forming polymer or polymers.

Finally, with regard to claim 25, the WO'646 publication does not teach or disclose that a film-forming polymer is an hydroxyl-functional acrylic polymer with  $M_n$  less than about 5000.

For all of these reasons, Applicants respectfully request withdrawal of the rejection and reconsideration and allowance of the claims.

#### Rejections for Obviousness-Type Double Patenting

Claims 1-25 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-23 of copending Application No. 09/850,837 and unspecified claims of copending Application No. 09/886,742. Applicants respectfully traverse this rejection and request reconsideration.

While the present claims are directed to clear coating compositions, the claims of Application No. 09/886,742 are directed to basecoat coating compositions. It is well known in the field that clearcoat compositions are transparent and that basecoat coating compositions are not transparent. Thus, rather than being a "purpose," the designation in the preamble of the type of composition provides a real limitation, and one well-known and recognized in this art.

Furthermore, the present claims include in the body of the claim the limitation "wherein the refinish composition is a refinish clearcoat composition." Thus, the Examiner's refusal to understand a real distinction provided by the preamble language does not excuse refusing to accord weight to a limitation in the body of the claims. The basecoat composition of the co-pending application is not clear, but rather is pigmented, as it positively recites in the bodies of the claims.

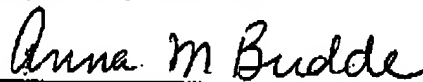
It is, therefore, submitted that the rejection for obviousness-type double patenting should be withdrawn. Reconsideration of the claims is requested.

#### Conclusion

Applicants believe that the claims are in condition for allowance, and an early allowance of the application is earnestly requested.

The Examiner is invited to telephone if it would be helpful to resolving any matter.

Respectfully submitted,



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Date February 17, 2004  
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